



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 108
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,967	11/13/2001	Arun Raghavendra Desai	95-472	6367

23164 7590 01/11/2007
LEON R TURKEVICH
2000 M STREET NW
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER

TRAN, NGHI V

ART UNIT	PAPER NUMBER
----------	--------------

2151

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/986,967

Applicant(s)

DESAI, ARUN RAGHAVENDRA

Examiner

Nghi V. Tran

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 8-9, 11, 13-16, 18, 20-23, 25, 27-28, 30, 32-35, AND 37 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 10, 12, 17, 19, 24, 26, 29, 31, 36 and 38 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed on July 15, 2005. Claims 1, 5-7, 10-13, 17-20, 24-26, 29-30, 32, and 36-38 have been amended. No claims have been canceled. Therefore, claims 1-38 are presented for further examination.

¶ 12.187 Reopening of Prosecution After Appeal Brief or Reply Brief

2. In view of the Appeal Brief filed on February 22, 2006, PROSECUTION IS HEREBY REOPENED. The second final rejection set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options: (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or, (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid. A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Art Unit: 2151

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2, 13-14, 20-21, and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Beyda, United States Patent Application Publication Number 2003/0061451 (hereinafter Beyda).

5. With respect to claims 1, 13, 20, and 32, Beyda teaches a method of providing content to a device [i.e. client 10, 12, and/or 14] according to Hypertext Transport Protocol (HTTP) [see abstract and figs.1-2], the method comprising:

- receiving an HTTP request [i.e. paragraphs 0016-0020] for a first content object [For example, the web page having the URL “www.cnn.com” has three graphic files and an audio file, the URLs of each of the graphic files and audio file is also listed under the main web page as sub-entries, see paragraph 0017. Therefore, Beyda teaches that sub-entry is a first content object];
- identifying a content operation identifier [i.e. URLs, paragraph 0017] that identifies a corresponding second content object [For instance, the web page

Art Unit: 2151

having the URL "www.cnn.com" has three graphic files and an audio file, the URLs of each of the graphic files and audio file is also listed under the main web page as sub-entries, see paragraph 0017. Therefore, Beyda teaches that sub-entry is a corresponding second content object] determined as relevant to the first content object by a predictive caching operation [paragraphs 0024-0028], the content operation identifier including a directive for prefetching the second content object as a content operation distinct from presentation of the first content object by the device [paragraphs 0021-0028]; and

- sending to the device an HTTP response to the HTTP request [paragraphs 0016-0028], the HTTP response including the first content object and the content operation identifier, enabling the device to perform the prefetching of the second content object based on receipt of the content operation identifier and distinct from the presentation of the first content object [figs.1-2].

6. With respect to claims 2, 14, 21, and 33, Beyda further teaches the identifying the step includes retrieving, based on retrieval of a first stored file containing the first content object, a second stored file associated with the first stored file and containing the content operation identifier [fig.2].

Art Unit: 2151

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-4, 6, 8-9, 11, 15-16, 18, 22-23, 25, 27-28, 30, 34-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beyda as applied to claims 1, 13, 20, and 32 above, and further in view of Schloss et al., U.S. Patent No. 6,249,844 (hereinafter Schloss).

9. With respect to claims 3, 6, 8, 11, 15, 18, 22, 25, 27, 30, 34, and 37, Beyda does not explicitly show the sending step includes adding to the first content object a content operation tag that specifies the content operation identifier including

In a method of providing content to a device, Schloss discloses the sending step includes adding to the first content object a content operation tag [figs.3-4 i.e. a content operation is interpreted as <include>] that specifies the content operation identifier including a directive tag [330 i.e. HREF statement to reference the persistent fragment] specifying the corresponding content operation to be performed by the device and an object identifier [i.e. "125.1" and "28.3"] that specifies a location of second content object [col.5, ln.36 - col.6, ln.30 i.e. indicating the reference to the fragment].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Beyda in view of Schloss by including a

Art Unit: 2151

directive tag because this feature is more flexible and make it easier to incorporate various type of dynamic information [Schloss, col.2, Ins.25-26]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Fishman in view of Schloss in order to generate different versions for different types of devices [Schloss, col.3, Ins.10-11].

10. With respect to claims 4, 9, 16, 23, 28, and 35, Beyda further teaches the first content object is a Hypertext Markup Language (HTML) document [paragraph 0017].

However, Beyda does not explicitly show the adding step including inline prepending the content operation tag from the second stored file into the HTML document.

In a method of providing content to a device, Schloss discloses the adding step including inline prepending the content operation tag from the second stored file into the HTML document [col.2, ln.33 - col.3, ln.32].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Beyda in view of Schloss by including inline prepending the content operation tag from the second stored file into the HTML document because this feature is more flexible and make it easier to incorporate various type of dynamic information [Schloss, col.2, Ins.25-26]. It is for this reason that one of ordinary skill in the art at the time of the invention would have been motivated to modify Fishman in view of Schloss in order to generate different versions for different types of devices [Schloss, col.3, Ins.10-11].

Allowable Subject Matter

11. Claims 5, 7, 10, 12, 17, 19, 24, 26, 29, 31, 36, and 38 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments with respect to claims 1-38 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2151

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi V. Tran whose telephone number is (571) 272-4067. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi Tran
Patent Examiner
Art Unit 2151

December 20, 2006



ZARNI MAUNG
SUPERVISORY PATENT EXAMINER